

Appl No. 10/628,737

Response dated October 29, 2004

Reply to Office Action dated September 29, 2004

## **REMARKS**

1. **Introduction.** Claims 1 – 15 are in the case. As shown below, in this response the Applicant is provisionally electing Species I, the invention of claims 1 – 9. However, Applicant is also presenting arguments to the Examiner that the application includes a generic claim. If the Examiner is not persuaded by the Applicant's arguments, claims 10 – 15 will necessarily be withdrawn from consideration.

2. **Restriction Requirement.** The Examiner imposed a restriction requirement and required Applicant to elect a single disclosed species. Specifically, the Examiner stated that the application contained the following three species:

Species I     the flip-flop circuit described at page 9, second paragraph, shown in Figure 2, and claimed in claims 1 – 9.

Species II    the flip-flop circuit described at page 11, second paragraph, and claimed in claim 10.

Species III   the flip-flop circuit shown in Figure 4 and claimed in claims 11 – 15.

Applicant hereby provisionally elects Species I. The Examiner further stated that if a generic claim was allowed no election would be required. Currently Applicant believes claims 1, 7, and 11 – 14 are generic claims. If the Examiner eventually allows one of the generic claims, Applicant of course withdraws the provisional election and wishes to have all claims allowed.

The Examiner does not state why the three Species constitute separate inventions. MPEP 806.04(d) defines an independent claim as follows.

Appl No. 10/628,737

Response dated October 29, 2004

Reply to Office Action dated September 29, 2004

It is not possible to define a generic claim with that precision existing in the case of a geometrical term. In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.

Using this definition, one can see, for example, that claim 1 is generic. Claim 1 does not include any limitations with regard to whether the transistors contained in the structure are P type or N type transistors. Under Applicant's claiming scheme, those types of limitations are not included until the dependent claims 2 - 6 and 8 - 9. Claim 7, while dependent on claim 1, is generic as well because it does not include any limitations as to whether the transistors should be P type or N type.

The invention of claim 10 has a structure that is similar to the invention of claims 1 - 9. The only difference is which transistors are P type and which transistors are N type.

The invention of claims 11 - 15 is related to the invention of claims 1 - 10, in that both devices reduce the number of clocked transistors in the flip-flop, thereby creating a significant power savings.

Appl. No. 10/628,737

Response dated October 29, 2004

Reply to Office Action dated September 29, 2004

3. Conclusion. Applicant believes that this paper responds fully to all of the items in the September 29, 2004 Office Action. While Applicant has provisionally elected Species I, Applicant believes that Claim 1 is generic for Species I and Species II. Applicant further believes that Species III is related but not distinct from Species I and II. Therefore, Applicant requests that the restriction requirement be withdrawn and that examination continue for all claims. If the Examiner believes a telephone conference will expedite the disposition of this matter the Examiner is respectfully invited to contact this attorney at the number shown below.

Respectfully submitted



Russel O. Primeaux

Reg. No. 37,213

KEAN, MILLER, HAWTHORNE, D'ARMOND,  
MCCOWAN & JARMAN, L.L.P.

P.O. Box 3513

Baton Rouge, Louisiana 70821-3513

Telephone: (225) 387-0999

Fax: (225) 388-9133

Email: [russel.primeaux@keanmiller.com](mailto:russel.primeaux@keanmiller.com)

[www.keanmiller.com](http://www.keanmiller.com)

Dated: October 29, 2004